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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,342	12/12/2000	Gabriel V. Lechuga		5231

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EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/735,342

Applicant(s)

LECHUGA, GABRIEL V.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12-30, 34-39 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 39 and 42, and amended claims 22-27, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 39 contains structure of a locking element not shown in the embodiment of figure 19 and therefore is not considered to be representative of the subject matter of this figure and applicable to that species, and claim 42 is dependent upon claim 22, which due to the addition of language claiming the fastener itself in claim 22, is now not directly related to the structure set forth in the elected embodiment of figure 19, and as stated in the previous office action, such make the claims non-elected by original presentation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-27, 39, and 42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

The abstract of the disclosure is objected to because it is too long in length and is not directed to the structure of the article being claimed but rather also includes benefits and other recitations which are not directly related to the article and its intended use. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### ***Double Patenting***

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,739,353. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure as claimed in the instant application is encompassed by the structure set forth in the patented claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmsderfer (463). The patent to Helmsderfer discloses the recited jacket for disposition around a pipe which can carry hot water to prevent contact and injury

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comprising, a jacket 30 having an outer wall and formed of a flexible material which is bendable and capable of being wrapped around a pipe portion, a slit 40 in the jacket allows it to fit about the pipe where the resiliency of the material allows the jacket at the slit to come together, fins 44 are provided on the inner surface of the jacket and project inwardly to contact the pipe and are longitudinally arranged, where the fins are made of the same flexible material as the sleeve and therefore are considered to inherently to be flexible and capable to deflect, but has resiliency enough to hold the weight of the jacket on a section of pipe through frictional engagement. Helmsderfer goes on to state in the specification column 5, lines 49-65, that the longitudinal ribs extend from end 34 to transition region 42 which would teaches thereby substantially interrupting with a gap of no ribs in regions where the jackets are curved to extend in a different direction, and that the ribs are continuous everywhere but in that section of the curve, thereby meeting the claim language, where column 7, lines 39-46, suggests the same for the 90 degree portion which is the point to which the ribs extend thereby meeting the substantial language of the claims.

Claims 31-33, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Trueb (730). The patent to Trueb discloses the recited jacket for disposition around a pipe which can carry hot water to prevent contact and injury comprising, a jacket 10,12,16 having an outer wall and formed of a flexible material which is bendable and capable of being wrapped around a pipe portion, a slit 28 in the jacket allows it to fit about the pipe where the resiliency of the material allows the jacket at the slit to come together, fins 31, 34 are provided on the inner surface of the jacket

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and project inwardly to contact the pipe and can be longitudinally arranged (col. 5, lines 1-7), where the fins are made of the same flexible material as the sleeve and therefore are considered to inherently to be flexible and capable to deflect, but has resiliency enough to hold the weight of the jacket on a section of pipe through frictional engagement (col. 3, lines 59-69). Trueb shows in figure 5, that the ribs do not extend in areas where the bend is large such as areas near 40 and 41 of the pipe it surrounds (the sleeve has no reference numbers with respect to these curved portions. Also, Trueb teaches that corrugations 46 cooperate with end portions of other pieces to ratchet together the successive pieces of sleeve which is the equivalent to a snap fit, where the structures at 46 and the ends of the sleeve portions can be seen to be the equivalent of protuberances and recesses where at least one end of the sleeve is seen to have a socket to receive the corrugated structure 46.

Claims 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Trueb (469). The patent to Trueb discloses the recited jacket for disposition around a pipe which can carry hot water to prevent contact and injury comprising, a jacket 10,12,16 having an outer wall and formed of a flexible material which is bendable and capable of being wrapped around a pipe portion, a slit 22 in the jacket allows it to fit about the pipe where the resiliency of the material allows the jacket at the slit to come together. Also, Trueb teaches that socket 42 can be provided with a protrusion that engages a recess at the end of sleeve portion 24 as seen in figure 3 and thereby forms a snap fit between the sleeves to lock the two sleeves together.

### ***Response to Arguments***

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Applicant's arguments filed April 29, 2004 have been fully considered but they are not persuasive. It is noted that applicant inadvertently failed to provide a corrected abstract as required in the first office action, a corrected abstract is requested with any further correspondence to correct the informalities set forth in the previous office action and repeated above. Applicant is thanked for making the record clear by supplying the April docket, although the explanation that the docket system was not based on receipt of papers was sufficient too. It is understood that applicant had mail troubles, the examiner just wants the record of the instant application to be clear and free of any possible errors which may come in question in future litigations. The examiner has no other issues other than wanting the record to be clear in order to avoid confusion in the future. With respect to the arguments directed toward the restriction requirement, the response to applicants petition sets forth the position of the office on this requirement, however, the examiner will try to address any other concerns that may not have been directly covered by the petition dismissal mailed on July 28, 2004. Even though applicant insists that the entire system of insulation sleeves must be used in order to meet codes and may be the intent of the use of the sleeves, it is still held that the different pieces are separately claimed and could be separately marked and sold without needing the other pieces, leaving it up to the user to buy all necessary parts to meet the code, however, such arguments are more or less addressed in the above mentioned petition dismissal. It is old and well known that various shaped pieces can be sold separately to allow the user to customize or choose the piece that best fits and matches their needs, and it is considered that each sleeve has it's own distinct features



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or else they would not have been claimed separately based upon their different features. Applicant has claimed separate sleeves as discussed in the previous office action and supported by the petition dismissal. The pertinent issue at hand is applicant has placed a burden on the examiner to search features set forth in various embodiments which is the basis for restriction requirements. With respect to the arguments directed toward claims 22-27 such are moot in the fact that based upon the amendment to these claims, the claims are now considered to read on a non-elected invention and have been withdrawn from further consideration based on the election by original presentation set forth above and explained in the previous office action of October 21, 2003. With respect to Helmsderfer, it is considered that the reference clearly discusses where the ribs begin and end and that such would meet the new claim limitations, see the rejection above for the pertinent portions of the prior art discussing this feature. In response to the concerns about the teachings of Trueb claiming all of the sleeve pieces, it is noted that Trueb deals with a single sleeve which can be sold as a unit and cut into it's individual sleeves which is quite different from a plurality of separate sleeves which are claimed based upon their individual features. With respect to Helmsderfer there are a plurality of patents some of which are from the same family and are divisionals of the parent case which suggests that such were likewise restricted based on the existence of plural species and inventions in the parent application, however, it is noted that all of this is immaterial as to the appropriateness of the restriction requirement in the instant application which stands on it's own based upon

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the manner in which the article is being claimed. Therefore, the restriction requirement still stands, and is further supported by the petition dismissal mentioned above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Trueb (255) and Helmsderfer (175, 237, 412, and 316) disclosing state of the art protection sleeves for pipes.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

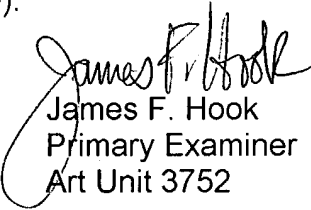
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (703) 308-2913. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James F. Hook  
Primary Examiner  
Art Unit 3752

JFH